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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,608	03/18/2004	Boris Farber	1428	5870

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Akron, OH 44308

EXAMINER

KAYES, SEAN PHILLIP

ART UNIT	PAPER NUMBER
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2841

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/803,608

Applicant(s)

FARBER ET AL.

Examiner

Sean Kayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-10 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asher (US 4891755) in view of Wike (US 6427915.)
3. With respect to claim 1 Asher discloses a method for automated tracking and identification nonuniform elements of a set, said method comprising the steps: initial weighing of and recording said weight of said completed set of nonuniform elements (column 1 line 66 – column 2 line 2); weighing of and recording said weight of each individual element of said set (column 2 lines 3-9 The individual items are measured in order to determine the weight of each class of item.); and after disassembly and reassembly of said set, verifying set completeness by comparison of the final weight and element quantity of said set (column 1 line 66 – column 2 line 2 and column 2 lines 10-17.) Asher does not disclose recording of an image of each individual element of said set.
4. Wike discloses a digital camera device 94a, figure 1. Furthermore, Cameras are very well known with regards to the art of inventory control.

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6. At the time of the invention it would have been obvious to one skilled in the art to include a camera, as taught by Wike, with Asher's invention.

7. The suggestion or motivation for doing so would be to resolve disputes. For instance if a customer claims that no item was removed from a mini-bar and that the invention is in error, the recorded camera images could be viewed to either verify the customer's claims or disprove them.

8. With respect to claim 2 Asher in view of Wike discloses the method of claim 1, wherein the weighing of each individual element of said set is prompted by an automatic tracking system and recorded within an electronic database for future recall (column 1 lines 66-column2 line 2, column 2 lines 10-17, and item 15, establish wherein the device reads the weight of the items and the recorded weight is then sent to and recorded by a central computer for billing purposes. Furthermore, the central computer would read and store the changes in weight as each new item is inserted in the mini-bar (during stocking.)

9. With respect to claim 3 Asher in view of Wike discloses the method of claim 2, wherein the recording of an image of each individual element of said set is prompted by an automatic tracking system and recorded within an electronic database for future recall (94a figure 1 of Wike is a digital camera.)

10. With respect to claim 4 Asher in view of Wike discloses the method of claim 3, wherein if set completeness cannot be verified, said automatic tracking system performs a counting and identification method comprising: a. Comparing the differences between said initial weighing and said final weighing to determine a differential weight (column 1

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lines 66-column 2 line 2); b. Comparing said differential weight against the weight of each individual element (column 1 lines 66-column 2 line 9); and C. Identifying a list of possible individual elements that could comprise said differential weight (column 2 lines 2-17.)

11. With respect to claim 5 Asher in view of Wike discloses an automatic tracking system for performing the method of claim 1, comprising: a scale (13 figure 1, Asher) for initial weighing of said completed set of nonuniform elements and each said individual element of said set; an image processing application (94a figure 1, Wike) for capturing, storing, and processing said image of each set element for storage in a computer data file; and electronic database (computer mentioned in column 2 lines 10-17 of Asher) recording and retrieval means for recording, retrieving, comparing and manipulating weight and image data identified or captured by said scale and said image processing application.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asher (US 4891755) in view of Almogaibil (US 5608193.)

13. With respect 6 Asher discloses a method for automated tracking and identification of instruments in a room environment comprising: a. Measuring the weight of individual instruments belonging to a complete standardized instrument set prior to an action by placed on a scale each said instrument one at a time according to a prompt (column 2 lines 2-9, each item's weigh is recorded in order to create a set); b. Storing the weights of the individual instrument in a computer data file (column 2 lines 2-17, the pertinent information is recorded on computer); c. Assigning a serial number to the

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complete standardized instrument set for allowing retrieval of information regarding instrument weights during an operation (column 2 lines 10-17, serial number is equivalent to a room number.) d. Automatically verifying set completeness during set assembly by the automatic counting and comparing of weights of measured pieces with nominal weights of this particular type of individual instrument stored in a database (column 1 line 66-column 2 line 17); e. If a mismatch occurs, then interactively pointing to potentially missing parts identified from said database (column 1 line 66-column 2 line 17.)

14. Asher does not disclose wherein said instruments are surgical or wherein the process is sterilization.

Almogabil discloses wherein a device such as that disclosed by Asher can be utilized to track tools and or medical/surgical tools (see Almogabil's abstract.) Furthermore, it would be obvious to sterilize the equipment prior to its use and Asher does disclose that the items should be measured prior to use.

At the time of the invention it would have been obvious to one skilled in the art to use Asher's invention in the use of tracking surgical tools as taught by Almogaibil.

The suggestion or motivation for doing so would be to allow a surgeon to track his tools and equipment in a safe accurate manner.

At the time of the invention it would have been obvious to one skilled in the art to sterilize the instruments after measuring their weight.

The suggestion or motivation would have been to prevent infecting the patient in the course of the operation.

***Allowable Subject Matter***

15. Claims 7-10 allowed.

***Response to Arguments***

16. Applicant's arguments filed 5/4/2006 have been fully considered but they are not persuasive.

17. With respect to applicant's first argument applicant asserts that Asher does not disclose or anticipate "recording an image of each individual element of said set." Applicant's attention is drawn to page 3 of the original office action lines 3-4. The office action asserts that "Asher does not disclose recording an image of each individual element of said set."

18. With respect to applicant's second argument applicant asserts that Asher does not disclose or anticipate "that the contents be returned to the refrigerator at all." The applicant's attention is directed to Asher column 2 lines 28-36, which clearly states an item being removed and returned.

19. With respect to applicant's third argument applicant asserts that the security camera in Wike is only for the purpose of recording an image of a customer, column 23 lines 2-4. However, Wike in fact does disclose recording images of the products being purchased and in fact the entire set of products present at the cash register, column 23 lines 54-67 and column 24 lines 1-12. Applicant's attention is also directed to read all of

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column 24 which discusses the use of the camera for determining set completeness of the purchased items.

19. With respect to applicant's fourth argument applicant implies that there is no motivation for combining the two references in either reference. Applicant's attention is directed to Wike column 23 lines 54-67. Wike discusses the motivation for including a security camera "serves as a psychological deterrent to the customer" ... "the customer is less likely to insert unscanned or otherwise unentered items (or substituted items) once the customer realizes that the checkout system has captured a video image of the customer's grocery bags."

20. With respect to applicant's last argument applicant asserts that the examiner is applying hindsight in the rejection to applicant's invention. As stated above Wike (column 23 lines 54-67) provides motivation for combining a security camera with Asher. Also [MPEP 07-37-03].

21. Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (for the reasons given in the last office action.)



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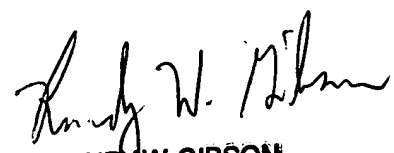
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Kayes whose telephone number is (571) 272-8931. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on (571)272-2119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SK

5/15/2006

  
RANDY W. GIBSON  
PRIMARY EXAMINER